



A green signal; and

A controller for selectively activating and deactivating the red  
and green signals.

In claims 10 and 11, the controller selectively displays and turns off the red and green signals, in claims 20-23 and 25-30 the controller selectively turns on and turns off the red and green signals.

In the 429 Patent, the analogous elements are a "model train red signal light" and "a model train green signal light".

As set forth in MPEP Section 804, a reliable test for double patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing corresponding claim in the Patent. Applicant respectfully submits that this is the case here. The Patent requires red and green signal lights. The present application requires only red and green signals. The signals could be lights but they could also be red and green painted signals, if for example, electricity was not available to power signal lights. Other possibilities are mentioned in the written description of the application, including WIG WAG or swinging banjo signals and target signals.

In addition, in the present application, the controller is said to activate and deactivate the red and green signals. This clearly covers not only illuminating lights as claimed in the Patent but moving a red or green signal into a visible position. This language is quite clearly broader than turning on and turning off signal lights as claimed in the Patent.

Some of the configurations shown in the present application could be argued not to be covered by the limitations red signal light and green signal light, but would be covered by the limitations "red signal and green signals". As set forth in re Vogel and Vogel 164 U.S.P.Q. 619,



by same invention, we mean identical subject matter. Thus the invention to find by a claim reciting "halogen" is not the *same* as that defined by a claim reciting "chlorine," because the former is broader than the latter. This is precisely the case here. A "red signal" is broader than a "red signal light" and therefore the claims are not appropriately rejected under 35 USC 101, Statutory Double Patenting. The disclaimer submitted with respect to the remaining claims is also effective to remove the double patenting rejection of Claims 1, 10, 11, 20-23 and 25-30.

Each of the grounds for rejection having been overcome, reconsideration and favorable action on the application are requested.

Dated: June 16, 2004

Respectfully submitted

HARTER, SECRET & EMERY LLP

By:

Stephen B. Salai  
1600 Bausch & Lomb Place  
Rochester, New York 14604  
585-232-6500